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In the Supreme Court

OF THE

United States

OCTOBER TERM, 1963

No. 318

SAFWAY PRODUCTS, INC. and R. D. WERNER CO., INC.,

Petitioners,

vs.

U-RIGHT, INC.,

Respondent.

On Petition for a Writ of Certiorari to the United States Court of Appeals for the Fifth Circuit

BRIEF FOR RESPONDENT IN OPPOSITION

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Respondent respectfully asks that the writ be denied.

PRELIMINARY STATEMENT

In this brief we will refer to pages in the brief and petition of petitioners as "P.B. . . .", and to the appendix to the petition and brief of petitioners as "P.A. . . ."

OPINIONS BELOW

The opinion of the Court of Appeals for the Fifth Circuit is reported at 315 F.2d 23, and is printed at P.A. 23-34.

The opinion of the District Court for the Northern District of Texas is unreported but is printed at P.A. 35-36.

JURISDICTION

The jurisdictional requisites are adequately set forth in the petition at P.B. 2.

QUESTIONS PRESENTED

The first three questions presented by petitioners may be rephrased as follows:

In an action for patent infringement, when a trial court makes findings of ultimate facts of infringement, based upon the application of the doctrine of equivalents to the patent in suit, the accused device and the prior art devices, is an appellate court bound by the rule that findings shall not be set aside unless clearly erroneous, or may an appellate court draw its own conclusions as to the ultimate question of infringement.

The fourth question presented by petitioners may be rephrased as follows:

Whether the appellate court below was correct in reviewing the prosecution in the Patent Office of the patent in suit, and in determining as a matter of law that the doctrine of file wrapper estoppel did not preclude

respondent from charging that the manufacture of petitioners' accused device is an infringement of the patent in suit.

The fifth question presented by petitioners concerns the question of validity of the patent in suit (a matter not yet determined by the District and Circuit Courts below) and may be rephrased simply as follows:

Whether the patent in suit is valid.

STATEMENT OF THE CASE

The present case is a typical suit for patent infringement. The essential facts are related with clarity and precision in the detailed and exhaustive opinion of the Court of Appeals. The following merely highlights the factors of particular significance.

Respondent is the owner of United States Letters Patent No. 2,438,173 for a portable and collapsible scaffolding unit, and brought suit for infringement based upon the manufacture and sale by petitioners of the accused scaffold.

Respondent's patent in suit, respondent's commercial scaffold, petitioners' accused scaffold and the prior art patents, publications and uses were all before the District Court. The scaffold devices are not complicated and the construction and operation of each device is readily understood. There was no dispute whatsoever as to the existence, construction and operation of the scaffolds of petitioners or respondent or of any of the prior art devices. There was some dispute in the testimony as to

the degree of speed, efficiency and safety of the patented and accused scaffolds, but such testimony in no way brought into dispute the construction, operation or intended result of these scaffolds.

The District Court concluded, upon a consideration of the construction and operation of the scaffolds and prior art before it, that the respondent's patent was entitled at most to only a small range of equivalents, and that the accused device did not fall within that range. The District Court also concluded that petitioners' scaffold was materially different in structure, mode of operation and result from the patented scaffold.

Having found non-infringement, the District Court declined to pass upon the validity of the patent in suit.

Detailed findings were adopted setting forth the construction and operation of the devices involved in the suit.

The Court of Appeals had before it the patent in suit, petitioners' and respondent's commercial scaffolds, and the prior art. The folding and unfolding of petitioners' and respondent's scaffolds was demonstrated at the oral argument. The opinion of the Court of Appeals indicates that it understood clearly the construction and operation of the devices involved in the suit.

The Court of Appeals then concluded that the patented and accused scaffolds were not substantially different in construction, operation and results, and that the District Court improperly applied the doctrine of equivalents to the patent in suit. The Court of Appeals decided that the accused device came within the scope of the claims of the patent in suit and that infringement did exist.

The Court of Appeals also reversed the District Court on the question of file wrapper estoppel and held that the respondent was not estopped by any of the proceedings in the Patent Office, to charge that the accused scaffold was an infringement of the patent in suit.

The case was remanded to the District Court for a determination of the question of validity. Thereupon, petitioners filed their petition for writ of certiorari.

ARGUMENT

CERTIORARI SHOULD NOT BE GRANTED TO REVIEW THE QUESTION OF INFRINGEMENT OF THE PATENT IN SUIT

This case turns on a determination of a question entirely peculiar to this case: Does the manufacture and sale of petitioner's scaffold infringe the claims of the patent in suit?

There is no dispute about the legal test that governs. If the accused device performs substantially the same function in substantially the same way to obtain substantially the same result as the patented device, then there is infringement. This has been clearly set forth by this Court in *Graver Tank & Mfg. Co. v. Linde Air Products Co.*, 339 U.S. 605 (1949), and was followed by the Court of Appeals below (P.A. 33).

Applying this test, the Court of Appeals held the accused scaffold to infringe the patent in suit. In reaching its conclusion, the Court of Appeals considered the patent in suit, accused scaffold and the prior art. These were not complicated devices, and there was no dispute

as to the existence, construction, operation or intended purpose of any of these devices. No testimony was necessary to explain the meaning of any terms of the patent or prior art, nor to resolve questions of the application of descriptions to subject matter.

The ultimate question decided by the trial court and appellate court was whether, from an examination of this undisputed evidence, infringement existed, that is, whether the accused scaffold and the scaffold of the patent in suit were substantially the same in construction, mode of operation and result. The trial court believed that an extremely narrow range of equivalents existed and held that there was no infringement. Upon an examination of the same undisputed devices, the Court of Appeals concluded that the patent was entitled to a broader range of equivalents and held that infringement did exist. In making its determination of this ultimate fact, the Court of Appeals was in as good a position to make such a determination as the District Court.

Petitioners now contend that the Court of Appeals is bound by the ultimate finding of the District Court regarding the question of infringement, and that the District Court cannot be reversed unless its determination of infringement is clearly erroneous. However, this court has long held in patent cases that if no evidence is needed to explain terms of art or to apply the descriptions of patents to the subject matter, and if the court is able from mere comparisons of the patent, accused device and prior art to determine whether the accused device is the same or different from the patented device, then the question of infringement is one of pure construction and

not of evidence and, consequently, is a matter of law for the court. *Heald v. Rice*, 104 U.S. 737 (1882); *Singer Mfg. Co. v. Cramer*, 192 U.S. 265 (1904); *Sanitary Refrigerator Company v. Winters*, 280 U.S. 30 (1929), *United States v. Esnault-Pelterie*, 303 U.S. 26 (1938).

The same rule is followed by the various circuits, namely, that in cases wherein the ultimate fact of infringement may be determined merely by a comparison of the patent and accused devices, the appellate court is not bound by the "clearly erroneous" rule. *Hanovia Chemical & Mfg. Co. v. David Buttrick Co.*, 127 F.2d 888 (C.A. 1, 1942); *Plax Corporation v. Precision Extruders*, 239 F.2d 792 (C.A. 3, 1957); *Industrial Instruments Corporation v. The Foxboro Co.*, 307 F.2d 783 (C.A. 5, 1962); *Del Francia v. Stanthony Corp.*, 278 F.2d 745 (C.A. 9, 1960).

The present case is not in conflict with the decisions of this Court in *Graver Tank & Mfg. Co. v. Linde Air Products Co.*, 336 U.S. 274 (1949) and 339 U.S. 605 (1950) where extensive testimony of experts was necessary to explain the subject matter of the suit in a field "where so much depends upon familiarity with specific scientific problems and principles not usually contained in the general storehouse of knowledge and experience" (339 U.S. at 610). The field of endeavor of collapsible scaffolds is not one which is incomprehensible to courts of law.

Petitioners also contend that the Court of Appeals is in error because it held the patent to be infringed even though the claims did not read literally on the accused scaffold. This is not erroneous, but follows the rule laid down by the Court in the *Graver* case, 339 U.S. 605, 607:

". . . One who seeks to pirate an invention, like one who seeks to pirate a copyrighted book or play, may be expected to introduce minor variations to conceal and shelter the piracy. Outright and forthright duplication is a dull and very rare type of infringement. To prohibit no other would place the inventor at the mercy of verbalism and would be subordinating substance to form. It would deprive him of the benefit of his invention and would foster concealment rather than disclosure of inventions, which is one of the primary purposes of the patent system. . .

* * *

". . . Though infringement was not literal, the changes which avoid literal infringement are colorable only. . . ."

CERTIORARI SHOULD NOT BE GRANTED TO REVIEW THE QUESTION OF FILE WRAPPER ESTOPPEL

In the present case the petitioners had relied upon the doctrine of file wrapper estoppel to escape liability for their infringement. The Court of Appeals, after a study of the file wrapper (the written history of the prosecution in the Patent Office) of the patent in suit, concluded that respondent was not estopped to charge petitioners with infringement.

This question, dependent upon the particular facts of this case, is not sufficient to warrant review by this Court.

General Talking Pictures Corp. v. Western Electric Co., 304 U.S. 175 (1938).

". . . Whether respondents acquiesced in the infringement and are estopped depends on the facts. Grant-

ing of the writ would not be warranted merely to review the evidence or inferences drawn from it. . . ."

There is no conflict in law of this case with the decisions in *Falkenberg v. Golding*, 195 F.2d 482 (C.A. 7, 1952) or *Westinghouse Electric Corp. v. Hanovia Chem. & Mfg. Co.*, 179 F.2d 293. In those cases it was held that, upon the facts presented, the patentee was estopped to charge infringement because he was attempting to recapture, revive or restore something which he had abandoned or surrendered in the Patent Office. In the present case, upon the facts here presented, the Court of Appeals held that there was no basis for file wrapper estoppel because the patentee did *not* try to recapture, revive or restore something that had been abandoned or surrendered in the Patent Office. Thus, the only conflict between the cases is in the final result of whether file wrapper estoppel applies, and not in the rule of law followed by the courts.

CERTIORARI SHOULD NOT BE GRANTED TO ADJUDICATE THE VALIDITY OF THE PATENT IN SUIT

The question of the validity of the patent in suit is premature. The District Court made no determination as to validity. The Court of Appeals made no determination as to validity, but has remanded this question to the District Court.

Furthermore, even if the Court of Appeals had held the patent in suit to be valid so that petitioners could seek review of that decision, then there would be no conflict between circuits, since the same patent has

already been held to be valid in the Ninth Circuit in *Beatty Safway Scaffold Co. v. Up-Right, Inc.*, 306 F.2d 626 (C.A. 9, 1963).

CERTIORARI SHOULD NOT BE GRANTED MERELY TO GIVE PETITIONERS ANOTHER HEARING

The determination by the Court of Appeals that petitioners have infringed respondent's patent rests on an *appraisal of the particular facts of this case*, and an appreciation of the particular circumstances of this case. As the Court has often said, it does not exercise its certiorari jurisdiction to review this kind of determination, or to give an unsuccessful party in a court of appeals another hearing.

> *Magnum Import Co. v. Coty*, 262 U.S. 159 (1923)
>
> ". . . The jurisdiction to bring up cases by certiorari from the Circuit Courts of Appeals was given for two purposes, first to secure uniformity of decision between those courts in the nine circuits, and second, to bring up cases involving questions of importance which it is in the public interest to have decided by this court of last resort. The jurisdiction was not conferred upon this court merely to give the defeated party in the Circuit Court of Appeals another hearing. . . ."

CONCLUSION

For the reasons set forth above, the petition for a writ of certiorari should be denied.

Dated, San Francisco, California,
August 20, 1963.

Respectfully submitted,

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